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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/879,825	06/12/2001	Craig W. Barnett	INVE0010-5	4591
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NEIFELD IP LAW, PC 4813-B EISENHOWER AVENUE ALEXANDRIA, VA 22304				
EXAMINER				
DURAN, ARTHUR D				
ART UNIT		PAPER NUMBER		
3622				
NOTIFICATION DATE		DELIVERY MODE		
12/20/2010		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

09/879,825

Applicant(s)

BARNETT ET AL.

Examiner

Arthur Duran

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 August 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 47-71 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 47-71 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/C2.06)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claims 47, 57, 64-71 have been examined.

Response to Amendment

The Amendment filed on 8/16/2010 is sufficient to overcome the prior rejection. However, a new 103 rejection has been made. Also, please note the BPAI Decision on Appeal dated 8/21/2008 where the rejection of 09/879,825 was Affirmed-In-Part.

Interference

As noted in 7/6/10 Interview, there are no more interference requests or issues with this case.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/16/10 has been entered.

Claim Objections

There two claim numbers 65 and 66. The claims need to be renumbered. Correction is required. For clarity purposes, Examiner will number the claim rejections below to match the current 8/16/10 copy of the claims. The features listed and the use of the headers independent and dependent before the claims below will help to clarify which claim is being addressed.

Claim Rejections - 35 USC § 112

Art Unit: 3622

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 66, 69, 47, 57 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed had possession of the claimed invention.

Claims 66, 69, 47, 57, amended 8/16/10, disclose "a particular network address".

The Examiner can find not support in the specification as disclosing the features of this claim. Examiner could find no "network address" identifying the client computer. The citations make reference to printing the user social security number or the user online service address. However, the citations make no reference to indicia identifying of said client COMPUTER.

The enablement must be consistent with the scope of the claims. Identifying the client computer can be interpreted to mean identification of the client's actual computer. This could be accomplished by the utilization of cookies or by recording a processor serial number or by recording a user device identification number.

The claims only have support for identifying the client's computer where this is interpreted to be the client's email or social security number or online service address. Hence, the Applicant's claims are broader than the specification and the claims are only supported in this narrower interpretation of the "client's computer" or of "network address".

And, importantly, the BPAI stated on 12/12/2005, in regards to related case 09/537,793, affirmed this similar 112 rejection as stated above. The BPAI on page 4 states:

"We will sustain the examiner's rejection of claims 47, 50, 52 and 53 for the reasons argued by the examiner. We agree with the examiner that each of the forms of identification discussed in appellants' specification identifies the user only and does not identify the user's computer. The user ID barcode, as disclosed, contains information which describes the user, not the user's computer. An online identification, such as an email address, also identifies the user and not the computer. A user can change computers and still receive email at the same address because the email address describes the user and not the computer. Thus, appellants' specification does not provide support for the recitation that the client computer is identified. Although most computer users may only use a single computer so that the identification of the user is tantamount to identifying the user's computer, the fact of the matter is that the types of identification described in appellants' specification only identify the user of the computer and do not uniquely identify the user's computer itself."

Hence, the "network address" will be interpreted as online service address or user online identification or email address of the user.

Also, Examiner notes that these 112 issues also apply to the dependent claims and to the features in the independent claims further involving the "network address".

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 47, 57, 64-71 are rejected under 35 U.S.C. 103(a) as being unpatentable over VonHohorn (5,227,874) in view of Saigh (5,734,823).

Independent Claims 66, 69, 47, 57:

Von Kohorn discloses a server system including a computer processor, associated memory, an input for receiving data, and an output for outputting data (Figs. 1, 3);

wherein said memory defines a database;

wherein said database stores coupon offer data defining available coupon offers, user record data defining user records, and targeting criteria applicable to said user records to determine which of said available coupon offers to associate with which of said user records (2:65-4:3; 3:31-37; 105:65-106:10; 105:15-23; claim 6; Figs. 33, 34; claim 27);

wherein each one of said user records stores

(1) a user identification that is different from all other user identifications stored in all other records of said user records (3:55-65; 2:20-30; Fig. 32; 3:30-37),

(2) information regarding coupons redeemed (2:20-30);

(3) data indicating which of said available coupon offers are to be offered (2:65-4:3; 3:31-37; 105:65-106:10; 105:15-23);

said server system programmed to respond to receipt over a network of a coupon request prompt, said coupon request prompt including a particular user identification, a particular network address, and identification of a particular one of said available coupon offers, by transmitting from said server system to said particular network address, data defining a particular coupon (3:30-37; 2:65-4:3; 2:20-30; 85:15-57),

wherein said data defining said particular coupon encodes both said particular user identification and said particular one of said available coupon offers, wherein said first coupon offer is a coupon offer associated in said database with said particular user identification (3:30-36); and

said server system being programmed to respond to receipt from a coupon redemption address of coupon redemption data indicating an attempt to redeem said particular coupon by comparing said coupon redemption data with said information regarding coupons redeemed in said database, to thereby determine whether said particular coupon was previously redeemed (2:20-27).

In further regards to claim 47, 57, wherein said electronic coupon includes data uniquely identifying the coupon relative to all other coupons transmitted by said first server system (2:20-30; 3:30-37; 85:15-57).

Also, on 8/16/10, Applicant made comments as to how Applicant states these claims can be interpreted, "In accordance with the present invention, the marketing

analysis, coupon packaging, and coupon package distribution functions carried out by the coupon distributor 16 may be carried out at the central data repository, i.e. Internet web site. Further, the coupon redemption and user redemption information processing functions individually carried out by the coupon redemption center 13 and the individual retail stores 10 may be combined into a single redemption center, as shown by the dotted line in FIG. 1. . .The claims now pending reflect the server centric embodiment in which the redemption center also performs web site and database functions (via limitations added to independent claims 47 and 57), which limitations also appear in new independent claims 66 and 69."

Hence, Applicant states that the claims can be interpreted as the functions of coupon distribution, analysis, and redemption all occurring at a central location or website.

Von Kohorn does not explicitly disclose electronic forwarding of the coupon or electronic redemption of the coupon. Von Kohorn does not explicitly disclose wherein said coupon is an electronic coupon and said person presenting said coupon does so by transmitting said coupon over a network. However, Von Kohorn discloses electronic sending of coupon related information that is also related to redemption (40:10-15). Also, Von Kohorn discloses that the response unit and a central computer are electronically connected over a network (Fig. 1, 3) and also several means for how the cumulative record data can be collected (claim 8, 9; 102:5-20; and, matrix in Specification). And, Von Kohorn discloses that the analyzing and tabulating can be performed by "computerized processing and analyses" (9:3-8; 9:33-40). Hence, as

shown, Von Kohorn states that analyzing/tabulating/etc can be performed by a computer. And, the MPEP states that automating a manual activity is obvious (MPEP 2144.04.III). And, Saigh discloses electronic redemption of coupons (14:15-15:10). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Saigh's electronic redemption of coupons to Von Kohorn's electronic coupon information and Von Kohorn's redemption of coupons at the merchant (8:43-50). One would have been motivated to do this in order to better allow shoppers to use and redeem coupons. Alternatively, it would have been obvious to one having ordinary skill in the art at the time of the invention to combine the features since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

In further regards to claim 47, 57, Von Kohorn further discloses a second server system connected to said communications channel, said second server system being adapted to establish a connection with said client system and for detecting said electronic coupon stored on said client system (Von Kohorn for the multiple computers, 94:30-45; Von Kohorn for the detecting, 90:60-91:20; 92:30-60; also, note that what applies to the card can apply to coupons 94:1-14, 90:60-91:20), said second server system further being adapted to redeem said electronic coupon (Saigh, 14:15-15:10). Also, note in the Applicant's stated interpretation above, the servers are all coming from the same central station/website. And, Von Kohorn discloses several computers at the

central station (94:30-45) and, Saigh discloses computers functioning as servers (Figs. 1, 3).

Dependent Claims 67, 70, 64, 66. Von Kohorn further discloses the system of claim 66 wherein said server system is programmed to store whether said particular coupon has been redeemed in said database (2:20-30).

Dependent Claims 68, 71, 65, 67. Von Kohorn further discloses the system of claim 66 wherein said server system is programmed to disallow redemption of said particular coupon if said comparing indicates that said particular coupon was previously redeemed (2:20-30; and the forgery, authentication, validation protections of 90:60-91:20; 92:30-60; 94:13-20; 95:3-10; also, note that what applies to the card can apply to coupons 94:1-14, 90:60-91:20).

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are moot in view of the new grounds of rejection.

Please note the BPAI Decision on Appeal dated 8/21/2008 where the rejections were affirmed in part. Also, Examiner notes that, subsequent to the BPAI decision, the Applicant filed an RCE on 10/7/2008. Hence, the affirmation of the rejection of those features is now part of the case history on this application.

Conclusion

The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

a) Saigh (5,734,823) discloses many relevant features for electronic coupons and websites and electronic coupon issuing and redemption.

b) and Deaton discloses many relevant coupon features.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (571)272-6718. The examiner can normally be reached on Mon- Fri, 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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8/25/2010